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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/435,461 11/05/99 DYSON

W GC593

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HM12/0409

EXAMINER

MELLER, M

ART UNIT	PAPER NUMBER
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1651

10

DATE MAILED:

04/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/435,461	DYSON ET AL.	
	Examiner	Art Unit	
	Michael V. Meller	1651	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2001.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7 and 10-20 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,10-13 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.                      20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims 14-16 and 18-20 which are drawn to an invention nonelected without traverse in Paper No. 5. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

The species election is also maintained and of record.

### ***Claim Rejections - 35 USC § 103***

Claims 1, 4-7, 10-13 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Lund et al., JP 05344897, Enomoto et al, Petersen, EP 214,761 or EP 476,915 taken with JP 52082774.

Applicant argues that Lund discloses nothing about modifying the surface of a polyester enzymatically and discloses nothing which relates to the polyesterase as claimed.

The claims do not require the surface of the polyester to be modified enzymatically. Further, the reference does teach that the properties of the polyester as

claimed by applicant are modified. Lastly, the polyesterase is disclosed, lipases, as noted by applicant in their specification in Table 1, are polyesterases.

Next, applicant argues that JP 05344897 mentions nothing about aromatic polyesters and further provides no information regarding the polyesterase as claimed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

This reference does not need to teach each and every claimed element since this rejection is under this section. A secondary reference is also provided which provides the motivation to use an aromatic polyester. Further, applicant is reminded that the reference does the use of lipases which are polyesterase as explained above.

Next, applicant argues that Enomoto (US 4876024 and EP 214761) does not relate to the instant invention which relates to polyesters prior to the application of a finish.

Applicant is reminded that the use of a polyesterase prior to the application of a finish is obvious since one would want to first modify the polyester before applying any finish to it, thus allowing the enzyme to properly do its job.

Petersen is said to not relate to the treatment of a polyester with a polyesterase, but as noted above, lipases are polyesterases.

EP 476915 is said to bear no relation to the treatment of the surface of a polyester with a polyesterase enzyme as claimed.

Applicant is reminded that the claims only require that a polyesterase (lipase) is used to modify a polyester.

Finally, applicant argues that JP 52082774 fails to fill the gap in the disclosures of the primary references despite its reference to aromatic polyesters. Next applicant argues that the abstract of this reference requires that the polyester be ground into a fine fiber or powder to increase the surface area.

Applicant's claims are directed to modifying with a polyesterase the pilling, weight, feel, appearance or luster of the properties of a polyester. Such modifications include many different kinds and a wide array of possible types of modifications. Thus, one of ordinary skill in this art would have been motivated to use aromatic polyesters since in JP 52082774 such aromatic polyesters are used which establishes that one of ordinary skill in the art knows about aromatic polyesters and to use aromatic polyesters is clearly within the purview of the skilled artisan since the reference also uses lipases to modify a polyester.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael V. Meller whose telephone number is 703-308-4230. The examiner can normally be reached on Monday thru Friday: 10:30am-7:00pm.

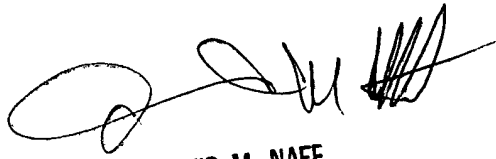
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-4743. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

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Art Unit: 1651

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MVM  
April 5, 2001

A handwritten signature in black ink, appearing to read 'D. M. Naff', with a large, stylized flourish at the end.

DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651